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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,450	08/21/2001	William L. Stebbings	55959US005	7329

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EXAMINER

LEWIS, KIM M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,450

Applicant(s)

STEBBINGS ET AL.

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/16/01, 3/4/02, 3/25/03 and 5/15/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29, 49 and 50 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 32-35, 42, 45, 53, 46, 53, 47, 53, 48, 53, 49, 53, 50, 53, 51, 53, 52, 53, 53, 53, 55, 61, 63 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5. 6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 3/14/02 and 5/15/03 have been received and made of record in the application file wrapper. Note the acknowledged PT0-1449 forms enclosed herewith.
2. The examiner wishes the applicant to note that international search report is acknowledged

Change of Address

3. The change of address paper filed 3/25/03 has been received and made of record in the application file wrapper. The applicant should note the change of address updated in our system.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The invention was made by joint inventors, however, the declaration recites original first inventor.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 30, 31, 36, 37, 46, 51, 52, 56, 57, 65 and 68-74, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 19, 50, 51, 53 and 54 of copending Application No. 09/847,941 ("the '941 application"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the '941 application claims anticipate claims 30, 31, 36, 37, 46, 51, 52, 56, 57, 65 and 68 of the instant application.

As regards claims 69-74, the '941 application discloses a method of making a medical article, the method comprises providing a medical article comprising a backing with a predefined tab located in a central portion of the backing and applying a stretch removable pressure sensitive adhesive to the backing (major surface) and pulling on the tab to stretch the medical article in an amount sufficient to remove the medial article.

The '941 application fails to teach pulling on the tab in a direction that is normal to the surface, pulling on the tab in direction that is not normal, pulling on the tab in a

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direction that forms an angle of about 20 degrees or more off the normal, and rotating the article to a nearly perpendicular orientation from its starting position.

The examiner contends that it would have been obvious to one having ordinary skill in the art to stretch/pull the medical article and/or the tab in any direction and in an amount sufficient to reduce the tack of the adhesive such that the medical article is removed from the skin since the adhesive is a stretch removable adhesive.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 38-41, 47-48, 58-60, 66 and 67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 14, 19, 50, 51 and 59 of the '941 application in view of copending application 10/180784 ("the '784 application").

As regards claims 38, 39, 58-60 the '941 application fails to teach that the adhesive layer comprises a fibrous reinforcing material within the pressure sensitive adhesive matrix, wherein the adhesive layer has a yield strength and a tensile strength, and wherein the tensile strength is about 0.7 MPa or greater, and at least about 150% of the yield strength.

However, the '784 application teaches an adhesive composition comprising a pressure sensitive adhesive matrix and a fibrous reinforcing material within the pressure sensitive adhesive matrix, wherein the adhesive layer has a yield strength and a tensile strength, and wherein the tensile strength is about 0.7 MPa or greater, and at least

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about 150% of the yield strength. The '784 application discloses that the fibrous reinforcing material provides an improved cohesive strength over the pressure sensitive adhesive only, yet the tack of the pressure sensitive adhesive remains substantially unchanged.

In view of the '784 application, it would have been obvious to one having ordinary skill in the art to provide the adhesive layer with fibrous reinforcing material in order to provide an improved cohesive strength over the pressure sensitive adhesive only, yet allow the tack of the pressure sensitive adhesive to remain substantially unchanged.

As regards claim 40, note claim 14 of the '784 application.

As regards claims 41 and 60, both the '941 and the '784 applications fail to teach the adhesive layer comprises an A-B-A block copolymer. Absent a critical teaching and/or a showing of unexpected results derived from the usage of an A-B-A block copolymer, the examiner contends that any stretchable block copolymer would perform equally as well, and that the selection of such is an obvious design choice.

As regards claims 47, 48, 66 and 67, the '941 application fails to teach the medical article is in the form of a wound dressing, surgical dressing, medical tape, athletic tape, or surgical drape. However, claim 30 of the '784 application teaches it is conventional to provide medical articles in the form of a wound dressing, a surgical dressing, medical tape, athletic tape, a surgical drape, a sensor, an electrode, or an ostomy appliance.

In view of the '784 application, one having ordinary skill in the art would have found it an obvious design choice to provide the medical article in the claimed forms in

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order to impart an improved cohesive strength to these conventional articles and yet have the tack of these conventional adhesive articles remain the same.

8. Claims 43, 44, 62 and 63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 12 of the '941 application in view of U.S. Patent No. 6,043,408 ("Geng").

As regards claims 43, 44, 62 and 63, the '941 application fails to teach a backing comprising two pieces, wherein the two pieces overlap. However, Geng discloses a medical article having a backing comprising two pieces, sheet material (4) having an opening and a flap (18) for covering the opening.

It would have been obvious to one having ordinary skill in the art to construct the medical article of the '941 application in the form of a dressing with backing comprising two pieces so as to provide an opening in the backing for viewing a wound and a flap for closing the opening when the wound is not being viewed.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

9. Claims 1-29, 49, 50 are allowed.

Claims 32-35, 42, 45, 53-55, 61, 63,64 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or fairly suggest to one of ordinary skill in the art a method of removing a medical article from the skin, comprising stretching the medical article in an amount sufficient to delaminate the adhesive layer from the backing and remove the medical article from the user.

The prior art of record also fails to teach a method of removing a medical article from skin, comprising selecting a backing and adhesive layer such that the stretchability of the adhesive layer is greater than that of the backing layer under the same tension.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays and Tuesdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703.308.1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.305.3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.

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Kim M. Lewis
Primary Examiner
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kml

September 26, 2003